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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Applicant: Yamamoto, Seto, Sato, Kuroki
Serial Number: 10/020764
Filed: 2001.12.12
Title: Substrate Laser Marking
Examiner: Hoa B. Trinh
Group Art Unit: 2814
Attorney Docket: 01-807

APPLICANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O Box 1450
Alexandria VA 22313-1450


Via Fax at 1.703.872.9306

Sir:

Pursuant to 37 C.F.R. 1.191, applicants hereby submit this brief on appeal from the examiner's final rejection of 2003.08.26 of claims 1-4 and 7-19, and from the Advisory Action of 2003.12.03. This brief is filed via fax in support of the notice of appeal filed via fax on 2004.01.05. Only one copy of this brief is filed, as the USPTO now receives faxes electronically, and can electronically generate as many copies as desired. However, applicants can fax multiple copies if they are desired. The Commissioner is authorized to charge the \$330 fee associated with the filing of this brief, and any other fees required such as extensions of time, to the LSI Logic Corporation deposit account number 12-2252.

I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d) on the date below.

2004.03.02
Date


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I. REAL PARTY IN INTEREST

The real party in interest is LSI Logic Corporation, a corporation of Delaware, and assignee of record of the entire right, title, and interest in and to the invention and application for patent thereon from the inventors Haruhiko Yamamoto, Hideaki Seto, Nobuyoshi Sato, and Kyoko Kuroki.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-4 and 7-19 are in the case. Claims 1-2, 4, 7, 11-17, and 19 are rejected under 35 USC § 102 over USPN 4,237,601 to Woolhouse et al. Claims 3, 8-10, and 18 are rejected under 35 USC § 103 over Woolhouse et al. Claims 5-6 and 20 have been cancelled. The claims on appeal are claims 1-4 and 7-19, as given in the Appendix.

V. STATUS OF AMENDMENTS

Applicants amended the claims in response to the first office action, which amendments have all been entered in the case. No amendments have been proposed subsequent to final rejection.

V. SUMMARY OF THE INVENTION

The summary of the invention is now provided with reference to claim 1. References to the text of the specification are made parenthetically, in the following manner (Spec. Page:Lines). References to the figures are also made parenthetically, in the following manner (Fig. Number:Element).

Claim 1 recites a method for a method for forming a feature (Fig. 2:12) in a substrate (Fig. 2:10), where residue (Fig. 1:16) within the feature (Fig. 2:12) can be easily removed (Spec. 6:5-8). An upper sidewall portion (Fig. 2:24) of the feature (Fig. 2:12) is formed by laser ablation (Spec. 5:12-13), where the upper sidewall portion (Fig. 2:24)

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forms a void (Fig. 2:12) (Spec. 5:20-23) in the substrate (Fig. 2:10). The upper sidewall portion (Fig. 2:24) has an upper sidewall angle (Fig. 2:β) (Spec. 5:14-19). A lower sidewall portion (Fig. 2:26) of the feature (Fig. 2:12) is formed by laser ablation (Spec. 5:12-13), where the lower sidewall portion (Fig. 2:26) forms a void (Fig. 2:12) (Spec. 5:20-23) in the substrate (Fig. 2:10). The lower sidewall portion (Fig. 2:26) has a lower sidewall angle (Fig. 2:δ) (Spec. 5:14-19). The upper sidewall angle (Fig. 2:β) of the upper sidewall portion (Fig. 2:24) is shallower than the lower sidewall angle (Fig. 2:δ) of the lower sidewall portion (Fig. 2:26) (Spec. 5:14-19).

As described in additional claims, the method is additionally directed toward forming indicia on integrated circuit substrates, which indicia remain clean and therefore highly visible during integrated circuit fabrication processes, and which also do not contaminate such integrated circuit fabrication processes (Spec. 5:29-6:8).

VI. ISSUES

Whether claims 1-2, 4, 7, 11-17, and 19 are patentable under 35 USC § 102 over USPN 4,237,601 to Woolhouse et al.

Whether claims 3, 8-10, and 18 are patentable under 35 USC § 103 over Woolhouse et al.

VII. GROUPING OF CLAIMS

Appellant considers that the claims on appeal do not stand or fall together. Accordingly, and for purposes of this appeal only, appellants suggest that the patentable subject matter of the application falls into nine groups as follows:

Group I consisting of claims 1 and 11 directed to a method for forming a feature in a substrate.

Group II consisting of claims 2-3 and 8-10 directed to a method for forming a feature in a substrate, where the feature has specific additional characteristics.

Group III consisting of claim 4 directed to a method for forming a feature in a substrate, where a specific order to the method is provided.

Group IV consisting of claim 7 directed to a method for forming a feature in a substrate, where an additional limitation is placed on the method.

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Group V consisting of claims 12-13 directed to a feature and a substrate including the feature formed by the method.

Group VI consisting of claim 14 directed to a method for forming indicia elements in a substrate.

Group VII consisting of claims 15-17 directed to a method for forming indicia elements in a substrate, where a specific order to the method is provided.

Group VIII consisting of claim 18 directed to a method for forming indicia elements in a substrate, where the indicia elements have specific additional characteristics.

Group IX consisting of claim 19 directed to a substrate including the indicia elements formed by the method.

VIII. ARGUMENTS

(I)-(II) There are no rejections falling under these sections.

(III) **WHETHER CLAIMS 1-2, 4, 7, 11-17, AND 19 ARE PATENTABLE UNDER 35 USC § 102 OVER USPN 4,237,601 TO WOOLHOUSE ET AL.**

The Group I claims, claims 1 and 11, are patentably distinct from the other groups because they are the broadest claims directed to forming a feature, and thus include a set of limitations that is broader than any of the other groups, as described more completely below.

Independent claim 1 claims, *inter alia*, forming a feature *by laser ablation*, where the feature has an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where the upper sidewall angle is shallower than the lower sidewall angle. Woolhouse et al. do not describe such a process. However, the examiner in the office action of 2003.08.26 states that "the upper sidewall portion and the lower sidewall portion [of Woolhouse et al.] *are formed by laser ablation of the substrate*" (emphasis added), and cites column 1, lines 25-30 and figure 2b of Woolhouse et al. in support of this statement.

The portion of Woolhouse et al. cited by the examiner actually reads as: "The wafer is then *cut* into two mutually orthogonal directions to form the individual diodes.

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First, the wafer is *cut* perpendicular to the intended *lasing facets* into bars of diodes, then the bars of diodes, following passivation of *lasing facets*, are *cut* into individual diodes" (emphasis added). The portions of this citation apparently referenced in support of the statement are presumably the two instances of the phrase "lasing facets." This phrase is apparently interpreted by the examiner as a statement of the method by which the wafer is cut. However, this is incorrect.

Woolhouse et al. generally describe the fabrication of laser diodes. The lasing facets referred to in the citation above are functional elements of the laser diode devices being formed, and thus do not refer to the method by which the cuts are made. Woolhouse et al. describe the methods by which the cuts are made in the sentence immediately following the portion of the specification cited by the examiner, which reads "*Cutting* of the wafer into bars is generally accomplished by cleaving the wafer through the substrate side, using an instrument such as a *razor blade, knife, scalpel blade or the like*" (emphasis added). Thus, there is no laser ablation describe in Woolhouse et al. at all.

Fig. 2b is also cited by the examiner in support of the notion that Woolhouse et al. use laser ablation to singulated or otherwise fabricate the devices. However, Woolhouse et al. describe figure 2b by stating that the "grooves are then *etched* into the bottoms of the channels *with an anisotropic etchant* that forms V-grooves 22, *as shown in cross-section in FIG. 2b*" (column 4, lines 39-41, emphasis added). A great deal of detail as to the specifics of the *chemical etch* are then provided. Absolutely no description of laser ablation of the wafer is given by Woolhouse et al. Thus, it is clear that Woolhouse et al. do not describe laser ablation of the wafer, while claim 1 clearly restricts the method to using laser ablation.

Therefore, claim 1 patentably defines over Woolhouse et al., and the rejection of claim 1 is in error. Dependent claim 11 depends from independent claim 1, and is likewise a Group I claim. Thus, claim 11 patentably defines over Woolhouse et al. Therefore, the rejection of claim 11 is in error.

The Group II claim, claim 2, is patentably distinct from the other groups because it describes a method for forming a feature in a substrate, where the feature has specific

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additional characteristics, and thus includes a set of limitations that is different from any of the other groups, as described more completely below.

Dependent claim 2 depends from independent claim 1 and claims, *inter alia*, forming a feature by laser ablation, where the feature has an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where the upper sidewall angle is shallower than the lower sidewall angle, and where the upper sidewall angle is from about thirty degrees to about sixty degrees. Woolhouse et al. do not describe such a process. Specifically, Woolhouse et al. do not describe laser ablating a feature having an upper sidewall angle of from about thirty degrees to about sixty degrees. Therefore, claim 2 patentably defines over Woolhouse et al., and the rejection of claim 2 is in error.

The Group III claim, claim 4, is patentably distinct from the other groups because it describes a method for forming a feature in a substrate, where a specific order to the method is provided, and thus includes a set of limitations that is different from any of the other groups, as described more completely below.

Dependent claim 4 depends from independent claim 1 and claims, *inter alia*, forming a feature by laser ablation, where the feature has an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where the upper sidewall angle is shallower than the lower sidewall angle, and the lower sidewall portion is formed before the upper sidewall portion. Woolhouse et al. do not describe such a process. Specifically, Woolhouse et al. do not describe laser ablating a feature where the lower sidewall portion is formed before the upper sidewall portion. Therefore, claim 4 patentably defines over Woolhouse et al., and the rejection of claim 4 is in error.

The Group IV claim, claim 7, is patentably distinct from the other groups because it describes a method for forming a feature in a substrate, where an additional limitation is placed on the method, and thus includes a set of limitations that is different from any of the other groups, as described more completely below.

Dependent claim 7 depends from independent claim 1 and claims, *inter alia*, forming a feature by laser ablation, where the feature has an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where

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the upper sidewall angle is shallower than the lower sidewall angle, and the feature is a blind bore. Woolhouse et al. do not describe such a process. Specifically, Woolhouse et al. do not describe laser ablating a blind bore. Therefore, claim 7 patentably defines over Woolhouse et al., and the rejection of claim 7 is in error.

The Group V claims, claims 12-13, are patentably distinct from the other groups because they describe a feature and a substrate including the feature formed by the method, and thus include a set of limitations that is different from any of the other groups, as described more completely below.

Dependent claims 12-13 depend from independent claim 1 and claim, *inter alia*, a feature formed by laser ablation, where the feature has an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where the upper sidewall angle is shallower than the lower sidewall angle, and a substrate having such features. Woolhouse et al. do not describe such features or substrates. Specifically, Woolhouse et al. do not describe features that are formed by laser ablation, which features have a far different physical appearance from features that are formed by the methods described by Woolhouse et al., as enumerated above. Therefore, claims 12-13 patentably define over Woolhouse et al., and the rejection of claims 12-13 are in error.

The Group VI claim, claim 14, is patentably distinct from the other groups because it is the broadest claim that describes a method for forming indicia elements on a substrate, and thus includes a set of limitations that is different from any of the other groups, as described more completely below.

Independent claim 14 claims, *inter alia*, forming indicia elements by laser ablation, where the indicia elements have an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where the upper sidewall angle is shallower than the lower sidewall angle. Woolhouse et al. do not describe such a process. Specifically, Woolhouse et al. do not describe laser ablating indicia elements. Therefore, claim 14 patentably defines over Woolhouse et al., and the rejection of claim 14 is in error.

The Group VII claims, claims 15-17, are patentably distinct from the other groups because they describe indicia elements that are formed according to a certain order of the

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method, and thus include a set of limitations that is different from any of the other groups, as described more completely below.

Dependent claims 15-17 depend from independent claim 14 and claim, *inter alia*, forming indicia elements by laser ablation, where the indicia elements have an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where the upper sidewall angle is shallower than the lower sidewall angle, and where (a) all upper sidewalls are formed before any of the lower sidewalls, (b) all lower sidewalls are formed before any of the upper sidewalls, or (c) one indicia element is completely formed before moving on to the next indicia element. Woolhouse et al. do not describe such a method. Specifically, Woolhouse et al. do not describe forming indicia elements by laser ablation in the different orders of formation as describe in claims 15-17. Therefore, claims 15-17 patentably define over Woolhouse et al., and the rejections of claims 15-17 are in error.

The Group IX claim, claim 19, is patentably distinct from the other groups because it describes a substrate including the indicia elements formed by the method, and thus includes a set of limitations that is different from any of the other groups, as described more completely below.

Dependent claim 19 depends from independent claim 14 and claim, *inter alia*, an integrated circuit substrate having indicia elements formed by laser ablation, where the indicia elements have an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where the upper sidewall angle is shallower than the lower sidewall angle. Woolhouse et al. do not describe such indicia elements. Specifically, Woolhouse et al. do not describe indicia elements that are formed by laser ablation, which indicia elements have a far different physical appearance from the cuts that are formed by the methods described by Woolhouse et al., as enumerated above. Therefore, claim 19 patentably defines over Woolhouse et al., and the rejection of claim 19 is in error.

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(IV) WHETHER CLAIMS 3, 8-10, AND 18 ARE PATENTABLE UNDER 35 USC § 103 OVER WOOLHOUSE ET AL.

The Group II claims, claims 3 and 8-10, are patentably distinct from the other groups because they are the only claims directed to forming a feature, where the feature has specific additional characteristics, and thus include limitations that are not described in any of the other groups, as described more completely below.

Dependent claims 3 and 8-10 depend from independent claim 1, and therefore claim *inter alia*, forming a feature by laser ablation, where the feature has an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where the upper sidewall angle is shallower than the lower sidewall angle, and where (a) the lower sidewall angle is from about sixty degrees to about ninety degree, (b) the upper sidewall portion has a depth of between about four microns and about eight microns, (c) the lower sidewall portion has a depth of between about four microns and about eight microns, or (d) the feature has a depth of no more than about twelve microns. Woolhouse et al. do not describe such a method. Specifically, Woolhouse et al. do not describe forming a feature by laser ablation with the specific physical characteristics as described in claims 3 and 8-10. Therefore, claims 3 and 8-10 patentably define over Woolhouse et al., and the rejection of claims 3 and 8-10 are in error.

The Group VIII claim, claim 18, is patentably distinct from the other groups because it is the only claim directed to forming indicia elements, where the indicia elements have specific additional characteristics, and thus includes limitations that are not described in any of the other groups, as described more completely below.

Dependent claim 18 depends from independent claim 14, and therefore claims *inter alia*, forming indicia elements by laser ablation, where the indicia elements have an upper sidewall portion with an upper sidewall angle, and a lower sidewall portion with a lower sidewall angle, where the upper sidewall angle is shallower than the lower sidewall angle, and where the upper sidewall angle is from about sixty degrees to about ninety degrees, the lower sidewall angle is from about sixty degrees to about ninety degrees, the upper sidewall portion has a depth of between about four microns and about eight microns, the lower sidewall portion has a depth of between about four microns and about eight microns, and the indicia element is a blind bore with a depth of no more than about

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twelve microns. Woolhouse et al. do not describe such a method. Specifically, Woolhouse et al. do not describe forming indicia elements by laser ablation with the specific physical characteristics as describe in claim 18. Therefore, claim 18 patentably defines over Woolhouse et al., and the rejection of claim 18 is in error.

(v) There are no rejections falling under this section.

IX. CONCLUSION

In light of the deficiencies of the rejections described at length above, claims 1-4 and 7-19 should be allowed and the rejections to these claims reversed.

Sincerely,

LUEDEKA, NEELY & GRAHAM, P.C.

By: 

Rick Barnes, 39,596

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APPENDIX

1. (previously amended) A method for forming a feature in a substrate, where residue within the feature can be easily removed, the method comprising the steps of:
forming an upper sidewall portion of the feature by laser ablation, the upper
5 sidewall portion forming a void in the substrate, where the upper sidewall
 portion has an upper sidewall angle, and
forming a lower sidewall portion of the feature by laser ablation, the lower
 sidewall portion forming a void in the substrate, where the lower sidewall
 portion has a lower sidewall angle,
10 where the upper sidewall angle of the upper sidewall portion is shallower than the
 lower sidewall angle of the lower sidewall portion.
2. (original) The method of claim 1, wherein the upper sidewall angle of the upper
sidewall portion is from about thirty degrees to about sixty degrees.
3. (original) The method of claim 1, wherein the lower sidewall angle of the lower
sidewall portion is from about sixty degrees to about ninety degrees.
4. (original) The method of claim 1, wherein the lower sidewall portion is formed
before the upper sidewall portion is formed.
5. (cancelled)
6. (cancelled)

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7. (original) The method of claim 1, wherein the feature comprises a blind bore formed in the substrate.
8. (original) The method of claim 1, wherein the upper sidewall portion has a depth of between about four microns and about eight microns.
9. (original) The method of claim 1, wherein the lower sidewall portion has a depth of between about four microns and about eight microns.
10. (original) The method of claim 1, wherein the feature has a depth of no more than about twelve microns.
11. (original) The method of claim 1, wherein the substrate comprises silicon.
12. (original) A feature formed according to the method of claim 1.
13. (original) An integrated circuit substrate having features formed according to the method of claim 1.
14. (previously amended) A method for forming indicia elements on a substrate, where the indicia elements have a shape that aids in removal of foreign material from the indicia elements on the substrate, the method comprising the steps of:
forming an upper sidewall portion of the indicia elements by laser ablation, the
5 upper sidewall portion forming a void in the substrate, where the upper
sidewall portion has an upper sidewall angle,

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forming a lower sidewall portion of the indicia elements by laser ablation, the lower sidewall portion forming a void in the substrate, where the lower sidewall portion has a lower sidewall angle,
10 where the upper sidewall angle of the upper sidewall portion is shallower than the lower sidewall angle of the lower sidewall portion, and forming the indicia elements in a pattern to form identifying indicia on the substrate.

15. (original) The method of claim 14, wherein all of the upper sidewall portions of all of the indicia elements are formed prior to forming any of the lower sidewall portions of any of the indicia elements.

16. (original) The method of claim 14, wherein all of the lower sidewall portions of all of the indicia elements are formed prior to forming any of the upper sidewall portions of any of the indicia elements.

17. (original) The method of claim 14, wherein a preceding one of the indicia elements is completely formed prior to forming a succeeding one of the indicia elements.

18. (previously amended) The method of claim 14, wherein:
the upper sidewall angle of the upper sidewall portion is from about thirty degrees to about sixty degrees,
the lower sidewall angle of the lower sidewall portion is from about sixty degrees
5 to about ninety degrees,

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the upper sidewall portion has a depth of between about four microns and about eight microns,

the lower sidewall portion has a depth of between about four microns and about eight microns, and

10 the indicia element is a blind bore formed in the substrate and has a depth of no more than about twelve microns.

19. (original) An integrated circuit substrate having identifying indicia formed according to the method of claim 14.

20. (cancelled)